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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/548,401	09/26/2005	Hiroshi Morisaki	05126	7990
23338 7590 10/06/2009 DENNISON, SCHULTZ & MACDONALD 1727 KING STREET SUITE 105 ALEXANDRIA, VA 22314				
EXAMINER				
NORDMEYER, PATRICIA L				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
10/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/548,401

Applicant(s)

MORISAKI ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Repeated Rejections

1. The 35 U.S.C. 103(a) rejection of claims 1 – 8 over Japanese Patent Application Publication No. 2-353 U in view of Barbieri (USPN 4,004,362) in the office action dated April 14, 2009 is repeated as Applicant's amendments and arguments in the response dated July 7, 2009 are found to be unpersuasive. The rejection is repeated below for Applicant's convenience.

With regard to the limitation of “wherein the cutting line is arranged and constructed to be ruptured therealong, so that the positioning tab can be separated from the tape body along the cutting line” in claim 1, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since Barbieri teaches that the cutting line penetrating through the tape body and the release sheet in the same location (Figure 1, #16; Figure 8, #28; Column 2, lines 42 – 44) is a perforated line, it is capable of being ruptured and separated.

JP 2-353 U discloses an adhesive tape (Figures 1 – 4), comprising: a tape body to be adhered to an adherend (Figures 1 and 2, #24), a positioning tab positioned on one end periphery of the tape body (Figures 1 and 3, #26), and a release sheet provided on a rear side of the tape body (Figure 1, #28), wherein the positioning tab and the tape body are interconnected via a connecting portion that is positioned there between, the connecting portion (Figures 4, #26) and

further including a cutting line penetrating through the tape body (Figure 2, #27) and the release sheet (Figure 3, the line separating #28A and 28B) as in claim 1. With regard to claim 2, the positioning tab is positioned along one end periphery (Figures 4, #26), and wherein the connecting portion is partly provided on one end periphery so that the tab is separated from the tape body other than the connecting portion (Figures 4, #26). As in claim 3, the release sheet is provided on the entire area of the rear side of the tape body (Figure 1, #28), and wherein the release sheet has a slit that is formed adjacent to the connecting portion (Figure 3, #28A and 28B). Regarding claim 4, the release sheet has an additional slit that is formed in a side periphery thereof (Figure 3, #28A and 28B). With regard to claim 5, the release sheet extends onto a rear side of the positioning tab beyond the connecting portion (Figure 1, #28). As in claim 6, the positioning tab has a fixing element that is positioned adjacent to the connecting portion (Figure 4, #26). Regarding claim 7, the tape body comprises an elongated tape body (Figure 3, #24), wherein the one end periphery of the tape body corresponds to one of longitudinally opposed end peripheries of the tape body, and wherein the slit is formed so as to extend along one of the laterally opposed end peripheries of the tape body (Figure 3, #28A and 28B). With regard to claim 8, the adhesive tape is designed to be applied to a vertical frame of a vehicle door, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. However, JP 2-353 U fails to disclose a cutting line penetrating through the tape body and the release sheet in the same location.

Barbieri teaches a tape body to be adhered to an adherend (Figures 1 and 8, #11), and a release sheet provided on a rear side of the tape body (Figures 1 and 2, #13), wherein a cutting line penetrating through the tape body and the release sheet in the same location (Figure 1, #16; Figure 8, #28; Column 2, lines 42 – 44) for the purpose of protecting the adhesive while controlling the removal of the backing layer (Column 2, lines 60 – 65).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the cutting line penetrating through the tape body and the release sheet in the same location in JP 2-353 U in order to protect the adhesive while controlling the removal of the backing layer as taught by Barbieri.

Response to Arguments

2. Applicant's arguments filed July 7, 2009 have been fully considered but they are not persuasive.

In response to Applicant's argument that Barbieri does not teach or suggest the recited amendment as line 16 is not meant to cut both the liner and adhesive tape, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Since Barbieri teaches that the cutting line penetrating through the tape body and the release

sheet in the same location (Figure 1, #16; Figure 8, #28; Column 2, lines 42 – 44) is a perforated line, it is capable of being ruptured and separated.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge is generally available to one of ordinary skill in the art as both references are directed towards adhesive products that deal with adhesive products have cuts in both the adhesive article and release liner. It would have been obvious to one of ordinary skill in the art to move the cut lines in JP 2-353 U to be lined up as Barbieri.

Conclusion

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794